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Applicant: Lyons, Michael L.

Application Title: Front Pocket Wallet Used to Prevent Spinal Misalignment

Examiner/GAU: Tri M. Mai/3727

Mailed: 2006 November 8

At: Gorham, Maine

APPEAL BRIEF

Commissioner for Patents


P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir

Pursuant to the Notice of Appeal mailed 2006 September 11, Applicant hereby submits his Appeal Brief
and the required small-entity fee.

Very respectfully,


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Date of Deposit 2006 November 8

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Nils Peter Mickelson
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APPEAL BRIEF

in

**APPLICATION SER. NR. 10/724,653
FILED 2003 December 1**

(NOTICE OF APPEAL ENTERED 2006 September 11)

REAL PARTY IN INTEREST

The real and sole party in interest in this Appeal is the Applicant, Michael L. Lyons.

RELATED APPEALS AND INTERFERENCES

None

STATUS OF CLAIMS

Claims 1-11 and 13-22 are cancelled.

Claim 12 is rejected.

Objection has been raised to Claims 14 - 22 as being dependent upon a rejected base claim (Claim 13). In his Final Action, the Examiner stated that these claims would be allowable if rewritten into independent form, which they have been in Amendment B after Final Action.

Pursuant to Amendment B, responsive to Final Action and mailed 2006 September 5, these re-written Claims 26-34 have been allowed.

Claim 12 is being appealed herewith.

STATUS OF AMENDMENTS

Amendment A, responsive to the First Office Action mailed 2005 November 16, was mailed 2006 February 16, with a correction for non-compliance mailed 2006 March 10, and its entry is confirmed.

Amendment B, responsive to Final Action mailed 2006 June 6, was mailed 2006 September 5. The subsequent Advisory Action mailed 2006 November 2 advises that Claims 26-34 are allowed if there are no other claims, and that the after-final limitations added to Claim 12 along with new Claims 23-25 raise new issues that would require further consideration and/or search.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 12 is directed to the shape (Page 1, Lines 23-26) of a pocket wallet (10). This shape has been determined from the shape of a front trousers pocket, to allow the user to properly use a wallet in such a shaped pocket (Page 3, Lines 5-7). Specifically, the wallet shape is otherwise generally rectangular, as with typical pocket wallets which today are worn in rectangular rear trousers pockets. The invention lies in the tapering (12) (Page 3, Line 5), which is substantially rounded, of one edge (13) of the wallet to remove material which otherwise would not fit properly in a front pocket and which would discomfort the user. The tapering shortens this edge (13), yet the structure of the wallet is still such that the full features of a pocket wallet are retained. As with conventional rectangular pocket wallets, this is a folding pocket wallet, characterized by a fold line (11) where the wallet may be conveniently folded from its open configuration (Figure 2) to its closed configuration (Figure 1) without damaging or being impeded by rigid (25, 52) or fragile objects maintained within the wallet.

GROUND S OF REJECTION TO BE REVIEWED UPON APPEAL

Claim 12 stands rejected under 35 U.S.C. §112, first paragraph, as containing subject matter allegedly not described in the specification — specifically the single fold line at one end.

Claim 12 also stands rejected under 35 U.S.C. §112, second paragraph, as allegedly failing to particularly point out and distinctly claim subject matter which the Applicant regards as the invention — specifically the "shorter edge."

Claim 12 stands further rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 601,922 to Wieland.

ARGUMENT

I. The Rejection of Claim 12 under 35 U.S.C. §112, First Paragraph

Background

Claim 12 replaced original Claim 1 which read, quite simply: "a wallet shaped to fit a front trousers pocket, said wallet having a substantially rounded tapering along one edge."

Taken word for word, Claim 1 should still stand. The Examiner has produced no evidence that convincingly discloses otherwise. To the contrary, the Examiner has provided many references which support that the shape of a "wallet" is a generally flat, folded object of generally rectangular shape, neither suited nor conducive to use in a front trousers pocket. The Applicant's invention is, and remains, a wallet — as in the conventional and contemporary use of that word — characteristically purchased in retail stores, used by persons wearing trousers who wish a conveniently inserted and withdrawn device, usually made of leather or other supple materials (flexible, pliant, but not connoting easily crushed) which have been developed over the years as leather substitutes.

Furthermore, contemporary advertisements such as that for the "Unisex Front Pocket Wallet" shown in the Day-Timer catalog of September 2006 (Exhibit I) and that found on the Websites:

www.ebags.com/search/index.cfm?feseaction=endecasearch&n=0&Ntt=front+pocket+wallet
and
www.frontpocketwallet.com

the latter of which is also the subject of 1991 U.S. Patent 5,024,258 to Morehead

affirm that there is current and ongoing interest and development in front pocket wallets, yet with a complete and obvious failure to realize or appreciate the advantages of the Applicant's invention. (The above three references are submitted herewith as Exhibits II, III and IV respectively.)

It is not the specifics of internal features of the wallet — pockets, card slots, transparent windows — but rather the shape of the wallet, as that shape influences its end use in a front trousers pocket, and more significantly the health benefits which accrue from the combination of the wallet's shape and its location with respect to the user's body, that distinguish the Applicant's invention.

In modifying cancelled Claim 1 to meet and overcome the Examiner's rejection in the first Office Action over U.S. Patent 5,671,481 to Giard, new Claim 12 has added unnecessary additional restrictions, each drawn from and completely supported by the Specification:

- a) a single fold line (11) at one end, when folded (at Page 3, Line 4)
- b) two edges (13, 16), one being a shorter edge (13) (at Page 3, lines 6 and 12)
- c) an end (17) opposite the single fold line (11) (at Page 3, Line 12)
- d) the "shorter edge" (13) having substantially rounded tapering (12) (at Page 3, Line 5)
- e) the "shorter edge" (13) defining the edge of a money pocket (24) (at Page 3, Line 15 and Page 4, Line 10)

Each of these limitations or features is graphically discussed in the Specification and clearly shown in the Figures. None is new. Each furthers the distinction of Claim 1, and thus Claim 12, over Giard '481.

The Examiner's Grounds for Rejection

In rejecting Claim 12, the Examiner states that it "contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention" because "the original disclosure does not support the single fold line at one end."

The Examiner goes on to add: "note that the multiple layers would form multiple fold lines at portion (sic) 11. This is a new matter rejection."

Arguments

What we have here is a simple failure to communicate. The Examiner reads the words "fold line" as being a crease formed after folding in each one of a multiplicity of layers. The Applicant selected the words "fold line" to indicate the place or line where the wallet is folded — a place which forms and thereby defines one end of the folded wallet, where prior to folding (as with a person's lap) there was merely a region of the unfolded wallet that was designed to preclude storage of fragile flat objects such as photographs (which should not be bent) and credit cards or planar electronic devices, for example (which *must* not be bent). Only flexible objects, such as folding money 26 disposed inside the money pocket 24, pass through this folding region of a wallet.

The existence of a single fold line is so ubiquitous to the common pocket wallet as to hardly need mention in a claim of today. We reach in our pocket, pull out the wallet, unfold it, and pull out the money. That the Examiner reads into this term a multiplicity of fold lines, one in each structural layer, reaches far beyond — and is completely unsupported by — the Specification. If a six-lane road makes

a bend to the left, there is only a single bend in the road. This divergence in language interpretation was extensively discussed in the after-final interview that took place on 2006 August 17, however the Examiner was unable or unwilling to come to agreement on any alternative term or terms which would implicitly communicate to him the Applicant's exact meaning, thereby stymieing the advancement of the case.

Claim 12 Amendments After Final Rejection

Further amendments of Claim 12 submitted after final rejection, that included additional modifiers such as "when in its closed position" and "a single and solitary fold about a fold-line," all of them discussed during the interview, have not been entered by the Examiner, on the grounds that they would require further consideration or search. The Applicant disagrees. The addition of these terms obviates both further consideration and search, and renders amended Claim 12 fully patentable.

Claim 12, as unamended, however, itself completely complies with 35 U.S.C. §112, first paragraph. The Specification contains a comprehensive description of the invention as claimed as shall be made clearer herebelow.

Provisional Figure 1

Figure 1 in the original Provisional Application mailed 2002 December 2 is the exact same data file as that used to create the completed formal Figure 1 drawing in the formal Application filed 2003 December 1. The provisional Figure 1 clearly shows a wallet shaped to fit a front trousers pocket and having a substantially rounded tapering along one edge, as well as:

- a) the shape of the invention — obviously a modified conventional pocket wallet — as folded in its closed configuration for placement in a front trousers pocket
- b) the single fold line at the left end
- c) the longest and the shorter edge adjacent to this fold line
- d) the one end opposite to the fold line
- e) the substantially rounded tapering of the shorter edge where it joins to the end
- f) the money pocket, the edge of which is defined by the shorter edge that is roundly tapered in a substantial manner to meet the end.

The Summary of the Invention

The Summary, at Page 1, Lines 23-26 in the formal Application, describes the shape of a front trouser pocket and how the invention is shaped to fit such a pocket: "a wallet which when folded, has a tapered end to better fit such a front pocket."

Exhibit V is a front trousers pocket, and Exhibit VI is an example of the Applicant's invention as shown and as claimed.

Figure 1 is furnished, as suggested in 35 U.S.C. §113, to aid if necessary in understanding the subject matter sought to be patented.

Formal Figure 1

Formal Figure 1 reveals, for improved clarity over the provisional, the vestiges of one internal separator panel 34 (though not labeled in Figure 1) as well as the stitching line 31. Shown once again in the formal Figure 1 are:

- a) the shape of the invention (10)
- b) a single fold line (11)
- c) the longest edge (16) and the shorter edge (13)
- d) the one end (17) opposite the single fold line (11)
- e) the substantially rounded tapering (12)
- f) the edge of the money pocket (24), though again not numbered in Figure 1, but rather immediately below in Figure 2.

The Specification

The Specification, at Page 3, Lines 3-7, describes in detail the shape or appearance of the wallet as shown in Figure 1 in its normal, closed configuration folded at fold line 11, and clearly explains how the unilateral, rounded tapering 12 of the wallet's shorter edge 13 causes it to approximate the shape of a typical trousers front pocket.

Physical Exhibits

A sample trousers front pocket was mailed to the Examiner with Amendment A as Exhibit III under 37 CFR §1.132 on 2006 February 16. See Exhibit V hereto.

The Claim Language of Claim 12

"A folding pocket wallet shaped to fit a front trousers pocket"

Though the preamble is not normally taken as limiting unless it breathes life and meaning into the claim, the Applicant's preamble in this case does exactly that. It does not suggest a generic apparatus, but rather a wallet — a folding pocket wallet — such that all further definition in the claim clearly depends from and centers on this topic alone. It must be taken and understood in that context — as a description of unique structure in such a folding pocket wallet. Moreover, this particular folding pocket wallet is "shaped to fit a front trousers pocket" and any delineation of it in the claim must be taken as descriptive of it "when in its folded-for-placement configuration."

To understand the invention, it is essential to know that it is a wallet. It is only by that wording that it can be known that the subject matter defined by the claim is comprised as a wallet. In a claim directed to an article, any phraseology in the preamble that limits its structure must be given weight. The determinations made in *Kropa v. Robie*, 187 F.2d 150, 88 USPQ 478 (CCPA 1951) and *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987) render this law.

In *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976), what was claimed was "a process *for* . . ." In *Kropa v. Robie*, what was claimed was "an abrasive article . . ." — just as in the Applicant's "I claim a folding pocket wallet . . ." "A process" is by its nature generic; "an abrasive article" and "a folding pocket wallet" are specific, and thus specifically limit the claim.

In *In re Stencel*, the body of the claim did not directly include the structure of the of the product, but the preamble did — as with the Applicant's preamble — and the court found the preamble could not be ignored. While the body of the claim is not directly limited to the wallet, the wallet structure recited in the preamble does limit the structure of the wallet. The framework against which patentability is measured is not all wallets broadly, but wallets which are folding pocket wallets shaped to fit a front trousers pocket. MPEP 2111.02.

Exhibits I through IV have been submitted to help understand the scope of the field of this invention, against which it must be considered.

"Comprising a single fold line at one and"

This phrasing is entered to define structure subsequently used in describing the invention. Because it is such an ubiquitous feature of the common wallet, and especially of the common folding pocket wallet, the single fold line is regarded out of hand as an expected element within the term "wallet" — and

especially so for a *folding* pocket wallet. This fold line forms one end of the wallet's shape when closed, and is used here to distinguish it from the opposite end which is distal from the fold line (see below).

"Comprising two edges adjacent said single fold line"

Again, these commonplace two edges are here entered for further use in describing the invention in the claim, and by their nature are endemic to the commonplace wallet.

"One of said edges being a shorter edge"

Here the Applicant distinguishes one of the two edges as unique, for further description, choosing the qualifier "shorter" in distinguishing this one of two edges.

"One end opposite to said fold line"

Here again, the end of the wallet — opposite to the fold line end — is recited for use in further refining structure. The word "end" is elected as being typical to the description of a rectangular object having two longer "edges" and two shorter "ends."

"Said shorter edge having substantially rounded tapering where it joins the end"

In these words lies the structural uniqueness of the Applicant's invention. At the corner defined by the intersection of the "shorter edge" and the "end" opposite the fold line, the shorter edge has "substantially" (largely, broadly; as opposed to trivially or merely) rounded tapering where it joins the end. At this point, the wallet of the invention uniquely differs from all prior wallets in no longer being simply rectangular in shape. It does not have a sharp corner, nor does it have simply rounded corners, as are so typically used in wallets to protect their corners from damage. As described in the Specification and further shown in Figure 1, the wallet here has markedly substantial rounded tapering, such that the user will be encouraged to place it properly in a front pocket rather than in a rear pocket, such that the so-shaped edge and end will fit a front pocket properly and thus distribute wear and contact forces more evenly upon the fabric at the bottom of the pocket, and such that the rounded (and thus missing) corner will not uncomfortably press against the muscular tissue on the top or front muscle of the thigh (technically, the rectus femoris of the quadriceps muscle), and the more pointed (insubstantially rounded) corner will fit comfortably into the softer recess of the thigh (above the adductor longus muscle).

"And (said shorter edge) defining the edge of a money pocket within said folding wallet"

These words are added to emphasize which edge is the shorter edge, the lack of which determination seemingly caused confusion in distinguishing over Giard '481. This concept of what constitutes "an edge" was extensively discussed during the interview on 2006 August 17.

Taken individually or together, the Provisional Application, the Summary and the Specification contain each and every element of a written description augmented where necessary by Figure 1 (per 35 U.S.C. §113) of the invention in full, clear, concise and exact terms (per 35 U.S.C. §112, first paragraph). There has been no new material, new process or new description entered or relied on in constructing Claim 12 than that which has existed since the conception and description of the invention in the Provisional Application or since the drafting of original Claim 1.

II. The Rejection of Claim 12 under 35 U.S.C. §112, Second Paragraph

Background

As discussed in the previous 'first paragraph' rejection, the allusion to any specific edge was added in new Claim 12 to help meet the Examiner's original rejection of Claim 1 over Giard '481, which discloses a sweatband with "slanted or curvilinear shapes" . . . "so that the folded panel has ends" (note the plural) "that are either cut along a diagonal direction or, more preferably, curved." While the Examiner should give the broadest reasonable interpretation to the claims, such interpretation must be consistent with the Specification, in which the Applicant's limitation of "substantially rounded tapering along one edge" is made manifestly clear.

The Examiner's Grounds for Rejection

In rejecting Claim 12, the Examiner states that the claim is indefinite for failing to point out and distinctly claim the invention because the term "'shorter edge' is confusing, i.e. shorter than what?"

Arguments

In point of fact, it is not relevant nor should it be required, that the invention be restricted to which of the two edges is tapered. No other wallet has its edges so tapered. Nevertheless, the Applicant grants that if, and only if, it is necessary to declare which edge he proposes to round, then it would best be the shorter edge, as shown.

The Applicant, in so claiming, makes reference to that edge which is described in the Specification and shown in the drawings as the "shorter edge 13." There is no ambiguity to this term. The Applicant has chosen it at his discretion because, when looking at the wallet as depicted in Figure 1 (or Figure 2) the substantially rounded tapering at the end of that edge removes material and makes it appear shorter than the opposite longest edge. When there are two edges, it is both grammatically correct and geometrically appropriate to call the shorter of the two edges "the shorter edge." Even if this were not so, there is no restriction on what term the Applicant must choose in naming this edge. Ambiguous terms such as "first edge" and "second edge" are perfectly acceptable and indeed typical in patent disclosures and claims. Moreover, it is this well-defined and distinctly supported "shorter edge" that is tapered, while it is the "end" that is stitched — a distinction that clearly supports Claim 12 as being directed to a folding pocket wallet.

The Applicant has not imported limitations from the Specification by reference into the claim. Rather, he has clearly discussed in the Specification the way in which his wallet is given a substantially rounded tapering along one edge.

The Examiner must interpret the claims as broadly as their terms reasonably allow — their plain meaning — unless the Applicant has provided a clear definition in the Specification. The Applicant has clearly done so. A wallet has one fold line, two edges and an end. If one edge has substantially rounded tapering, it of course becomes a shorter edge.

III. The Rejection of Claim 12 under 35 U.S.C. §102(b)

Background

Original Claim 1, from which Claim 12 derives, was rejected in the first Office Action in light of Giard '481 on the grounds that Giard discloses:

- a wallet
- shaped to fit in (a) front trousers pocket
- having rounded tapering around one edge.

In drafting Claim 12, the Applicant overcame this rejection by more specifically claiming elements of structure, attempting to meet the Examiner's rejection not only by arguing the distinct differences between Giard's sweatband and the Applicant's wallet, but also by adding phrasing to the claim that more distinctly describes the Applicant's invention within the claim itself, with less reliance on the specification. This palliative phrasing, however, also narrows the Applicant's claim.

Nevertheless, and subsequently in his Final Action, the Examiner raised a new reference — Wieland 601,922 — in rejecting this newer and narrower Claim 12. This new reference was unexpected, as was the Final Action citing it.

The Examiner's Grounds for Rejection

In rejecting Claim 12, the Examiner states that Claim 12 is anticipated by Wieland '922 because Wieland teaches:

- "a folding pocket wallet having a single fold line (between panels g in Fig. 3)"
- "two edges (one at f and the other shorter edge at portion c in Fig. 1)"
- "one end opposite to the fold line (at b)"
- "the shorter edge having substantially round tapering (at h) where it joins the end."

Further in rejecting Claim 12, the Examiner goes on to add: "With respect to the wallet obviates spinal misalignment, note that it is an intended use."

Arguments

"a folding pocket wallet having a single fold line (between panels g in Fig. 3)"

The Examiner's statement that Wieland '922 teaches a wallet having a single fold line is incorrect. Wieland '922 shows clearly in Figure 2 (and in his first claim) that his wallet has two fold lines — not one single fold line. Wieland's first fold line (not numbered for reference in his drawing) is at a transverse fold, seen in Figure 2 as an approximately horizontal crease extending left-to-right just a short ways below the lowest of the three lowercase "a" characters, and described at Column 1 Line 49: "where the blank is folded the first time."

Wieland's second fold line is at a longitudinal fold, more or less vertical in Figure 2, formed after the first fold has been completed. Wieland describes his second fold as a "lengthwise" fold (Column 2, Line 70).

The Applicant's wallet is folded once, at one single fold line.

"two edges . . . the shorter edge having substantially round (sic) tapering . . ."

Wieland mentions "edge" nowhere but in his claims — in Claim 1 at Column 2, Line 92; in Claim 2 at Column 3, Line 5; and in Claim 3 at Column 4, Lines 23 and 24 — where he refers to his "one end edge only" and "one edge only." Wieland provides no antecedent in his Specification for the use of "edge"

in his claims, but from the text as a whole one understands that his "one edge only" is where the first fold occurs — the transverse first fold described above. Nowhere does Wieland's "one end edge only" teach, reveal or hint at having any rounding or tapering.

But from the Examiner's reasoning, one can gather that the Examiner is referring to corner h as having "substantially round tapering." Wieland himself describes this at Column 2 Lines 76-78, where he teaches that "one outer front corner of each fold preferably is rounded, as shown, to remove sharp corners that would be liable to injury." Here it should be noted that Wieland, in his 1898 contemporary usage, applies the noun "fold" to mean "a part laid (or layered) over another part" and not to mean a crease or a line along which an article is folded, as might be more typical usage today.

Regarding this corner h, the Applicant draws attention to two important aspects of Wieland's teachings:

1. Wieland's pocket-book is taught as composed of stiff paper (Column 1, Line 32), where any exposed corner, and especially any single or un-reinforced corner such as each individual "fold" of outer front corner h would be easily subject to damage, or in Wieland's contemporary wording "liable to injury," from contact with a harder surface or object. In part, this may be seen as deriving from his intention to use his book as an advertising medium, whose unblemished appearance has an intrinsic value of its own.
2. Wieland uses, appropriately, the passive voice "liable to injury," as contrasted with the active voice "liable to cause injury," because he is concerned with injury to his product, and not with any injury his paper product may cause to the user.

The Applicant agrees with the Examiner in saying Wieland's corner is "substantially round," since it appears to truly be a characteristic "radiused corner" as is so typically provided on almost any manufactured object (except perhaps knives). Being "substantially round" however is totally different from being "substantially rounded." The first refers to how closely (substantially) its form or shape conforms to "round;" the second refers to the degree or extent of roundedness and tapering: a tapering, which is substantially rounded.

One contemporary example of such rounding as is envisaged and taught by Wieland would be the rounded corners of three-ring notebook paper. In drafting technical drawings for a machined part, for another such example, it's customary to add a general note instructing the machinist to "break all sharp edges" to render those edges less prone to injury from being struck against other objects. Even the Applicant, as shown consistently in each of his Figures 1 through 5, anticipates such a typical rounding process, showing without any discussion rounded corners at virtually every corner.

The Applicant's invention specifically centers on his substantially rounded tapering along one edge. Wieland neither shows nor envisions any tapering at all. The Applicant claims tapering — rounded tapering, not linear tapering — along one edge. The Applicant does not claim a rounded or a radiused corner. Virtually all wallets, to protect their corners, have die-cut rounded corners so that they can look newer longer. Wieland rounds his one corner because it is the only corner where individual layers of stiff crushable paper appear vulnerably exposed and separated. All his other corners are doubled by folding or reinforced by binding — a fact which he goes at length to discuss (Column 2, Lines 76-78). No one would be led by Wieland's teachings to provide a "substantially rounded tapering."

The word "substantial" as used by the Applicant in Claim 12, takes its customary meaning, both in daily usage and in conventional claim construction: "important," "essential," "ample," "full," "being specified to a large degree (as in a substantial victory)," "considerable," "large," "of considerable value." Here it means much more than simply rounding off a corner to protect the corner from damage; it means, for example, half the entire width of the wallet, so that the wallet's shape fits a front trousers pocket.

The Applicant uniquely provides substantially rounded tapering, across a significantly broader region, than in any prior wallet. This is positively-recited novel structure.

Wieland's rounding ("one outer front corner h of each fold preferably is rounded, as shown, to remove sharp corners") does not anticipate and does not inherently possess the characteristic of the Applicant's "substantially rounded tapering." Substantially rounded tapering does not in any way necessarily flow from the teachings of Wieland '922, as is required in *ex parte Levy*, 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990).

While the degree of rounding in Wieland's drawings should never alone be inferred or be scaled from its appearance in his drawings, Wieland's teachings in his specification disclose that the corner is merely rounded to remove vulnerable sharp corners. *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

That a certain characteristic may be present in the prior art is not sufficient to establish inherency, as made clear in *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). Note that Wieland says (Column 2, Lines 74-75) "each fold *preferably* is rounded" — and not that it simply "is" rounded.

Wieland's paper pocket-book is so different in its construction, its properties, and its intended use that it clearly does not necessarily possess the characteristics of the Applicant's folding pocket wallet. *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977). As a paper pocket book with open ends to permit the projection of long documents (Column 1, Lines 39-45) and in the era of Wieland's invention (1898),

his "pocket-book" with advertising printed on its surfaces must be understood to be used in a pocket of a gentleman's jacket (then a normal part of daily wear) and certainly never intended to be used in any trousers pocket where it would be crushed by sitting, bending over or mounting a horse.

Indeed, the Applicant's wallet is stitched closed at the end — not left open — and is intended for use in a front trousers pocket. All conventional pocket wallets are taken as stitched at their ends. Its structure solves an entirely different problem from that posed by Wieland, and this different problem is positively recited in Claim 12.

Wieland '922 does not teach all the structural limitations of Claim 12, as it must to anticipate the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter 1987). Even if Wieland's pocket-book could be forced into a front trousers pocket, it cannot anticipate the claim, due to its structural differences. *In re Ruskin*, 347 F.2d 843, 146 USPQ 211 (CCPA 1965). *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994).

A claim is anticipated only if each and every element *as set forth in the claim* is found, either expressly or inherently described in a *single* prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Moreover, Wieland '922 does not constitute an enabling disclosure because even one skilled in the art would find no teaching in Wieland of a substantially rounded tapering that would suggest it could operate as the Applicant's invention. A reference contains an enabling disclosure if the public was in possession of the claimed invention before the date of invention. The public was not in such possession, either with Wieland '922 alone or even in combination with other references. *In re Sasse* 629 F.2d 675, 207 USPQ 107 (CCPA 1980); *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968); *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

In order to constitute anticipatory prior art, a reference must identically disclose the claimed device *In re Schoenwald*, 964 F.2d 1122, 22 USPQ2d 1671 (Fed. Cir. 1992). Drawings and pictures can only anticipate claims if they show clearly that structure which is claimed (*In re Marz*, 173 USPQ 25 (CCPA 1972) including all the claimed structural features and the exact manner in which they are put together to anticipate the claim *Jockmus vs. Leviton*, 28 F.2d 812 (2d Cir. 1928).

In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute." What constitutes a "sufficient specificity" is fact-dependent. (MPEP 2131.03). The mere fact that prior art wallets, including Wieland '922, may generically disclose rounded corners does not constitute sufficient specificity to anticipate the Applicant's substantially rounded tapering that produces unanticipated and substantial health benefits. These unanticipated results serve also to render the claim unobvious (MPEP 2131.03).

The Applicant notes that the Examiner's comment regarding "intended use" is incorrect. The intended use of the Applicant's invention is its use as a wallet in a front trousers pocket. Its extraordinary benefits to spinal alignment, sciatica and neurological health are novel and unanticipated *results* — they are not intended uses. The recitation of use as a front pocket wallet in fact does result in structural differences between the invention as claimed and the prior art, and it does in fact patentably distinguish the claimed invention from the prior art.

The Applicant's wallet is in no way constructed or arranged as in Wieland '922, nor does it serve the same purpose, nor does its use provide health benefits. Wieland '922 does not anticipate the Applicant's invention of a wallet with a single fold line at one end, two edges adjacent to it, one of which is a shorter edge that is tapered in a substantially rounded fashion so as to fit a front trousers pocket and avert spinal and neural damage.

No prior art structure is capable of performing the functions of the Applicant's invention.

Conclusion

The rejections of Claim 12 under 35 U.S.C. §112, first paragraph, §112, second paragraph, and §102(b) are not supported.

CLAIMS APPENDIX

12. (new) A folding pocket wallet shaped to fit a front trousers pocket, said front pocket wallet, when folded for placement in a front trousers pocket, comprising

- (a) a single fold line at one end;
- (b) two edges adjacent said single fold line, one of said edges being a shorter edge; and
- (c) one end opposite to said single fold line;

said shorter edge having substantially rounded tapering where it joins said end and defining the edge of a money pocket within said folding pocket wallet, whereby use of said folding pocket wallet obviates spinal misalignment and neural damage.

EVIDENCE APPENDIX

U.S. Patent 601,922 to Wieland: cited by the Examiner in final Office Action mailed 2005 November 16

U.S. Patent 5,671,481 to Giard: cited by the Examiner in first Office Action mailed 2006 June 6

Exhibit I: copy of page from Day-Timer catalog of September 2006

Exhibit II: printout from Website <www.ebags.com>

Exhibit III: printout from Website <www.frontpocketwallet.com>

Exhibit IV: U.S. Patent 5,024,258 to Morehead

Exhibit V: example of a front trousers pocket

Exhibit VI: example of the Applicant's invention

Exhibit VII: a photographic print of the Applicant's invention

Exhibit VIII: printout from Website <www.roguewallet.com> owned by Applicant

Exhibit IX: example of promotional postcard for the Applicant's invention

Exhibit X: Press Release dated November 2006

Exhibit XI: printout from Google search for "front pocket wallet"

Exhibit XII: Point-of-Sale placard

Exhibit XIII: printout from Website <www.all-ett.com>

Exhibit XIV: printout from eBay Website

EXHIBIT I

Exhibit I is a copy of page 78 from the Day-Timer catalog of September 2006, showing the Unisex Front Pocket Wallet. Notable is the deliberate claim to "rounded corners" as an important feature, yet clearly not anticipating the Applicant's "substantially rounded tapering" that results in his invention's better fit and greater benefits.

Day-Timer is a subsidiary of ACCO Brands Corporation, and "has been the leader in personal planning and organization for nearly 60 years." Their current recognition of front pocket wallets is a testament to the commercial importance of this new field of products.

EXHIBIT II

Exhibit II is a printout from the Website <www.ebags.com> showing the result of a search for all products under "front pocket wallet."

Twenty (20) products are found, none showing the realization of the Applicant's unique "substantially rounded tapering" that results in his invention's better fit and greater benefits.